

60,427-282  
2000P07905US01REMARKS

This paper is responsive to the Non-Final Office Action mailed on April 13, 2007.

Applicant respectfully requests reconsideration of this application.

Claims 1-6 and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,748,748 (the '748 patent) in view of official notice. The Examiner contends that the '748 patent teaches an air induction system having an air induction body, a speaker, a control unit having at least two modes of noise attenuation signal generation, and an engine sensor. The Examiner argues that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the '748 patent to provide a control unit which selects a first driving mode in response to a high engine speed and a high engine load and selects a second driving mode in response to a low engine speed and a low engine load to achieve less disturbance to the driver, to others on the road, and to the surrounding neighborhood. Applicant respectfully disagrees.

The proposed combination cannot be made because a *prima facie* case of obviousness under 35 U.S.C. §103 is not established. Whenever there is no benefit to making a proposed combination, there is no *prima facie* case of obviousness. In this instance, there would be no benefit to modifying the control unit of the '748 patent in the proposed manner because the '748 patent discloses only changing an undesirable oscillation into a desirable oscillation as a function of an operating condition of the vehicle (see column 3, line 43 to column 4, line 28). That is, there is only one mode of noise attenuation disclosed with the system, i.e., the sports car mode. Because there is only one mode of noise attenuation contemplated by the '748 Patent, it would be useless

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to program the control unit of the '748 Patent with the ability to select between two or more driving modes. The Examiner is improperly using hindsight to make the proposed combination. Applicant's claims are not obvious.

In addition, Applicant challenges as improper the Examiner's assertion of official notice. Pursuant to MPEP 2144.03, notice of facts beyond the record must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re: Knapp Monarch Company*, 296 F2d 230 (CC PA 1961)). It is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. Here, Applicant challenges that it was well known prior to Applicant's invention to have a control unit which selects a first driving mode in response to a high engine speed and the high engine load and selects a second driving mode in response to a low engine speed and a low engine load. In light of this, Applicant respectfully requests that the Examiner provide documentary evidence to support the alleged fact in order to maintain the present rejection.

Accordingly, claims 1-6 and 20-22 are in condition for allowance.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: 

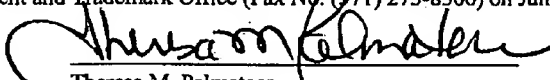
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CERTIFICATE OF FACSIMILE

I hereby certify that this Request for Reconsideration, relative to Application Serial No. 09/901,237 is being facsimile transmitted to the Patent and Trademark Office (Fax No. (71) 273-8300) on June 26, 2007.

  
Theresa M. Palmateer

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